

**REMARKS**

Claims 1-22 were pending in this application.

Claims 1, 2, 6-13, and 17-22 have been rejected.

Claims 3-5 and 14-16 have been objected to.

Claims 1, 2, 12, and 13 have been amended as shown above.

Claims 1-22 remain pending in this case.

Reconsideration and full allowance of Claims 1-22 are respectfully requested.

**I. ALLOWABLE CLAIMS**

The Applicant thanks the Examiner for the indication that Claims 3-5 and 14-16 would be allowable if rewritten in independent form to incorporate all elements of their respective base claims and any intervening claims. Because the Applicant believes that the remaining claims in this application are also patentable, the Applicant has not rewritten Claims 3-5 and 14-16 in independent form.

**II. OBJECTION TO DRAWINGS**

The Office Action objects to the drawings because the drawings do not illustrate the “five inverters” recited in Claims 10, 11, 21, and 22. With this Amendment and Response, the Applicant includes a Letter to the Official Draftsperson along with a proposed amendment to the drawings. In particular, the Applicant proposes to amend Figure 3 to include two additional

inverters 360, 370. The Applicant respectfully submits that no new matter has been added. The Applicant respectfully requests entry of this amendment.

As a result of this amendment, Figure 3 would illustrate five inverters 330, 340, 350, 360, 370. Accordingly, the Applicant respectfully requests withdrawal of the objection to the drawings.

### **III. REJECTION UNDER 35 U.S.C. § 112**

The Office Action rejects Claims 6, 7, 17, and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, the Office Action notes that Claims 6, 7, 17, and 18 are indefinite because their recitations stand “in contrast to” their respective base claims.

Claims 1 and 12 as amended recite “one or more inverters.” Claims 6 and 17 recite “one inverter.” Claims 7 and 18 recite “one CMOS inverter.” Claims 6, 7, 17, and 18 are acceptable dependent claims because they narrow the scope of their respective base claims. In particular, Claims 6, 7, 17, and 18 recite a single inverter, while Claims 1 and 12 allow for more than one inverter.

Based on this, Claims 6, 7, 17, and 18 narrow the scope of Claims 1 and 12 and do not contradict or attempt to broaden the scope of Claims 1 and 12. Accordingly, the Applicant respectfully requests withdrawal of the § 112 rejection.

**IV. REJECTION UNDER 35 U.S.C. § 103**

The Office Action rejects Claims 1, 2, 6-13, and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over the Applicant's cited prior art ("*ACPA*") in view of U.S. Patent No. 4,948,995 by Takahashi ("*Takahashi*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The Office Action acknowledges the *ACPA* does not disclose that a "status signal is an input signal to the voltage divider." (*Office Action, Page 3, Paragraph 3*). The Office Action then asserts that *Takahashi* discloses these elements of Claims 1 and 12 and that it would be obvious to combine *Takahashi* with the *ACPA*. (*Office Action, Page 3, Paragraph 3*).

*Takahashi* discloses a "disabling circuit" used to detect a "power-on event." (*Abstract*). The disabling circuit includes a "level detecting circuit" and a "complementary inverter circuit." (*Abstract*). Both are connected to a single power source through a power switch. (*Figure 3*).

First, the Office Action asserts that the level detecting circuit of *Takahashi* includes two transistors 12, 13, so this anticipates a voltage divider. (*Office Action, Page 3, Last paragraph*). However, *Takahashi* fails to disclose that these transistors act as a voltage divider. In fact, *Takahashi* lacks any mention of using any type of "voltage divider."

Second, the disabling circuit of *Takahashi* is designed and used in a circuit where only a single power source is used. The Office Action contains no explanation as to why one of ordinary skill in the art would use a disabling circuit designed for use with a single power

source in a system that uses multiple power supplies as recited in Claims 1 and 12. Moreover, the Office Action contains no explanation as to why one of ordinary skill would have a reasonable expectation of success for combining the *ACPA* and *Takahashi*, given that the circuit of *Takahashi* uses a single power source.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claims 1 and 12 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection and full allowance of Claims 1, 2, 6-13, and 17-22.

V. **CONCLUSION**

For the reasons given above, the Applicant respectfully requests reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicant has included a Petition for Extension of Time and the appropriate fee for a one (1) month extension of time. No additional fees are believed to be necessary. However, in the event that any additional fees are required for the prosecution of this application, please charge any necessary fees to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: \_\_\_\_\_

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